

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim for Foreign Priority

The Applicant appends copies of forms PCT/1B/304 and 308. (See APPENDIX) These forms respectively demonstrate notification concerning submission/transmittal of priority documents and notifying the Applicant of the communication of the International Application to the designated offices. These forms also indicate that all of the requirements of Rule 17 were met. That is to say, there is no * or NR beside the date of receipt of the priority documents thus indicating that they were submitted in full compliance with Rule 17.1(a) or (b).

17.1 Obligation to Submit Copy of Earlier National or International Application

(a)

Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, **certified** by the authority with which it was filed ("the priority document"), shall, **unless already filed with the receiving Office together with the international application** in which the priority claim is made, and subject to paragraph (b), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(Emphasis added)

Rule 17.2 states:

17.2. Availability of Copies

(a) Where the applicant has **complied** with Rule 17.1(a) or
(b), the International Bureau shall, **at the specific request of the designated Office**, promptly but not prior to the international publication of the international application, **furnish a copy of the priority document** to that Office. **No such Office shall ask the applicant himself to furnish it with a copy.** The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(Emphasis added)

The Applicant therefore submits that it is the task of the PTO to obtain the certified copies of the priority documents.

Allowed Subject Matter

The allowance of claims 1-24 is noted with appreciation.

The Specification

The specification has been amended in a manner which overcomes the objections raised on page 6 of the Office Action. Inasmuch as there is only a single inventor named on this application, the amendment to page 79 is such as to change "CLAIMS" to "WHAT IS CLAIMED IS" instead of "We Claim."

Claim Amendments

In this response, it is proposed to amend claim 25 in a manner which clarifies the subject matter which is being claimed. More specifically, claim 25 has been amended to call for the oblique image acquiring optical system and the frontal image acquiring optical system to comprise a single, two-dimensional imaging device which is common to the oblique image acquiring optical system and the frontal image acquiring optical system. Claim 30 has been amended to correct an inadvertent typographical error.

Rejections under 35 U.S.C. § 112

In this rejection claim 28 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. However, it has been indicated that this may be resolvable by applicants pointing out the precise portions of the specification and/or drawings which correspond to the limitations which are set forth in this claim. In accordance with this suggestion, the applicants call attention to page 48, lines 5-11, and page 49, line 7 to page 50, line 10. It is submitted that these passages describe the features of the invention in sufficient detail to render the subject matter of claim 28 both clear and definite.

Rejections under 35 U.S.C. § 103

The rejection of claims 25-31 under 35 U.S.C. § 103(a) as being unpatentable over Miyoshi (U.S. Patent No. 4,897,536) in view of Mori et al. (U.S. Patent No. 6,215,959), further in view of Yamamoto (U.S. Patent No. 5,583,602), to the degree that it still pertains to the claims as amended, is respectfully traversed.

In traverse, it is pointed out that the combination is improperly based on the mere conclusion that these references are analogous art. More specifically, it is stated that the motivation for combining the references would have been to incorporate the displacement sensing features of Miyoshi into the already disclosed analogous range finding mechanism [into] of an auto-focus camera (of Mori). As will be appreciated, this does not amount to motivation as required under 35 U.S.C. § 103 and would not lead the hypothetical person of ordinary skill in the art to consider this allegedly obvious transfer of teachings. It is submitted that "incorporation" of the type mentioned above, is not "motivation." In fact there must be "motivation" before "incorporation" can be prompted.

Further, the rejection clearly acknowledges that Miyoshi does not explicitly disclose that it is “combined or should be combined” with any other imaging apparatus or device elements. This admission is seen as further reducing the tenability of the rejection in that it suggests that Miyoshi contains no disclosure/suggestion which might be considered to be motivating to the hypothetical person of ordinary skill.

It is well established that there must be some positive suggestion which stems from the art before a *prima facie* case of obviousness can be established. In fact, in rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221a USPQ 929, 933 (Fed. Cir. 1984). These showings by *facie* case of obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

To render the rejection even less tenable, it is admitted that the Mori reference, which is cited to remedy the shortcoming of Miyoshi, itself does not disclose that the 2D image is captured photoelectrically. The rejection then cites Yamato to remedy this second acknowledged shortcoming.

It is submitted that, in order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be able to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required.

It is submitted that the rejection fails to meet this burden.

Miyoshi discloses a displacement sensor in which a measurement light or beam that is produced using a He-Ne laser, is directed to a surface of an object the distance of which is being measured. The light reflected from this surface is received by a line sensor placed on the same axis as the light imaging lens. Displacement is measured based on the change in the imaging location on the line sensor. This arrangement uses a light shielding plate in which slits are formed to permit the reflected beams to impinge on a CCD line sensor.

Mori discloses an auto-focus camera in which a measurement light is directed to an object, and wherein the reflected light is received by a sensor system which is associated with a reception optical system 3 that is adjacent the photographing optical system 1.

Yamamoto discloses an auto-focus digital camera in which a CCD imaging device is used to photoelectrically capture two-dimensional images.

The rejection asserts that the above references are from a similar problem-solving area wherein a system in which an imaging system first determines the range to the object with a measurement beam, is used. However, it is respectfully submitted that there is no indication in the rejection as to whether there is a particular problem involved and no indication that the three references are directed to solving the same problem or even problems which are relatively similar. The blanket assertion that they are of the same "problem area" is completely insufficient to provide any meaningful direction to the person of ordinary skill who is in possession of the references in question.

Indeed all that can be reasonably concluded is that the three cited references relate to optical apparatus wherein light is used to determine distance and/or produce images. The myriad of different problems that can be involved with this type of endeavor is self-evident and would not provide any specific suggestion to the hypothetical person of ordinary skill when confronted with the content of the three references.

Claim 25 has been amended to call for both the oblique image acquiring optical system and the frontal image acquiring optical system to commonly use the same single two-dimensional imaging device. With this arrangement it is possible to display an image

on a monitor without any distortion due to a video signal obtained from a two-dimensional imaging device (frontal image acquiring optical system) and without impairing the original function of measuring displacements (oblique image acquiring optical system). Further, because the same two-dimensional imaging device is commonly used it can be employed for the photoelectric conversion of the oblique image and the photoelectric conversion of the frontal image. This differentiate over the arrangements of Mori and Yamamoto which both use separate devices and which, as far as the references which are cited, tends to establish a trend toward using separate arrangements as different from that which is currently set forth in claim 25.

With the common use of a single device a sensor head according to claim 25 can be produced at a much lower cost.

Conclusion

It is respectfully submitted that none of the cited references describes or suggests the use of a common (two-dimensional) imaging device in the manner which is now claimed. In fact, the art thus far cited tends to teach toward separate devices. Accordingly, favorable reconsideration of the rejection of claims 25-31 and the allowance of this application is courteously solicited.

Respectfully submitted,

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